

The opinion in support of the decision being entered today was *not* written for publication in a law journal and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YOSHINOBU SERA

Appeal 2007-0389
Application 09/855,149
Technology Center 3600

Decided: March 23, 2007

Before MURRIEL E. CRAWFORD, ANITA PELLMAN GROSS, and ROBERT E. NAPPI, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Sera (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 18, which are all of the claims pending in this application.

Appellant's invention relates to a system and method for placing orders for an item or service over a network. Claim 1 is illustrative of the claimed invention and reads as follows:

1. A network commerce system comprising:

an orderer terminal for interaction with an orderer ordering an item or service;

a plurality of producing/processing terminals each for interaction with a producer/processor, said producer/processor producing and processing said item or providing a produced and processed item, in accordance with an order from said orderer terminal;

wherein said orderer terminal and said producing/processing terminal are interconnected via said network; and

a headquarters terminal including a receiver for receiving an image data order from said orderer terminal transmitted via said network and a transmitter for transmitting the order received by said receiver to a producing/processing terminal via said network;

said headquarters terminal selectively determining said producing/processing terminal in accordance with a received order and then making the selected producing/processing terminal produce and process said item or provide a produced and processed item.

The prior art reference of record relied upon by the Examiner in rejecting the appealed claims is:

Garfinkle US 6,512,570 B2 Jan. 28, 2003
(effectively filed Dec. 24, 1996)

Claims 1 through 18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Garfinkle.

We refer to the Examiner's Answer (mailed October 27, 2006) and to Appellant's Brief (filed August 21, 2006) and Reply Brief (filed September 25, 2006) for the respective arguments.

SUMMARY OF DECISION

As a consequence of our review, we will reverse the anticipation rejection of claims 1 through 18.

OPINION

Appellant contends (Br. 14-19) that Garfinkle fails to disclose a headquarters terminal as recited in independent claims 1, 14, 15, 16, 17, and 18. More specifically, Appellant contends (Reply Br. 3) that Garfinkle fails to disclose that the headquarters terminal selectively determines the producing/processing terminal, as recited in each of the independent claims. We agree.

Garfinkle discloses (Garfinkle, col. 5, ll. 1-12) that digital images are stored on an image server. Garfinkle further discloses (Garfinkle, col. 6, ll. 37-46) that a photographer orders prints or photographic merchandise of the digital images through the image server. The image server and the photographer are connected via the Internet (see Garfinkle, col. 6, ll. 53-55). Garfinkle discloses (Garfinkle, col. 10, ll. 28-39) that a fulfillment center receives the order from the image server and fills the order. Thus, Garfinkle's photographer corresponds to the claimed orderer terminal, the fulfillment center corresponds to the claimed producing/processing terminal, and the image server satisfies the claimed headquarters terminal.

However, each claim further recites that the headquarters terminal selectively determines the producing/processing terminal according to the received order. Garfinkle states (Garfinkle, col. 10, ll. 23-24) that "the photographer **8** selects a fulfillment center **20** which they prefer to use to fulfill all orders placed." Thus, Garfinkle's orderer terminal (the photographer) selectively determines the producing/processing terminal (the fulfillment center), not the headquarters terminal (the image server). Therefore, as Garfinkle lacks a feature of each of the independent claims, Garfinkle fails to anticipate the claims. Accordingly, we cannot sustain the anticipation rejection of claims 1 through 18.

REMARKS

Each of claims 14 through 17 recites one element of the system "comprising" all of the elements of the system. For example, claim 14 recites "*[a] headquarters terminal comprising:* orderer terminals ...; producing/processing terminals ...; and *a headquarters terminal* ..." (emphasis ours). It is unclear how one element can "comprise" the whole system including that element. Thus, the Examiner should consider a rejection under 35 U.S.C. § 112, second paragraph.

Appeal 2007-0389
Application 09/855,149

ORDER

The decision of the Examiner rejecting claims 1 through 18 under 35 U.S.C. § 102(e) is reversed.

REVERSED

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